



Docket No.: 66729/P017US/10405597
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mark Lesswing et al.

Application No.: 09/577,386

Confirmation No.: 3851

Filed: May 23, 2000

Art Unit: 3627

For: NOVEL METHOD AND APPARATUS FOR
REPRICING A REIMBURSEMENT CLAIM
AGAINST A CONTRACT

Examiner: V. Frenel

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the rejections in the present Office Action (mailed January 24, 2007) for the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below.

REASONS FOR REQUESTED PRE-APPEAL REVIEW

Claims 1-86 are pending in the present application. Claims 1-11 and 24-86 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,704,044 issued to Tarter et al. (hereinafter "*Tarter*") in view of U.S. Patent No. 6,529,876 issued to Dart et al. (hereinafter "*Dart*"). Claims 12-23 have been withdrawn pursuant to a restriction requirement, but remain pending in the present application. Applicant respectfully submits that the outstanding claim

rejections are improper, and thus requests pre-appeal review of the rejected claims in light of the remarks presented herein.

I. Incorrect Identification of Pending Claims

As an initial matter, the current Office Action incorrectly identifies the pending claims as claims 1-11 and 24-86. In fact, claims 12-23 also remain pending in the present application, as Applicant has not canceled those claims. In response to the Restriction Requirement mailed September 21, 2004, Applicant provisionally elected claims 1-11 and 24-70 WITH TRAVERSE. An Office Action mailed August 3, 2005 maintained and made final the Restriction Requirement. However, Applicant maintains that the Restriction Requirement is improper, and thus submitted a Petition for the Director to reconsider the restriction in accordance with 37 C.F.R. § 1.144. Applicant is still awaiting a response to such petition. In the meantime, all of claims 1-86 remain pending in the current application.

II. History of Rejection

A Final Office Action rejecting the claims of the present application was previously mailed May 31, 2006. The Final Office Action rejected claims 1-11 and 24-86 under 35 U.S.C. § 103(a) as being unpatentable over *Tarter* in view of U.S. Patent No. 5,191,522 issued to *Bosco* et al. (hereinafter "*Bosco*"). In response, Applicant did not file an Amendment After Final Rejection, but instead filed a Notice of Appeal and then a supporting Appeal Brief.

In response to the Appeal Brief, the Examiner reopened prosecution and presents the above-identified new ground of rejection, which again relies on the *Tarter* reference as teaching or suggesting certain claim elements (as in the Final Office Action of May 31, 2006), but replaces the *Bosco* reference with *Dart* reference. Applicant maintains that, for the reasons presented in the Appeal Brief and briefly presented below, *Tarter* fails to teach or suggest those claim elements for which the Examiner cites it. Thus, both the previous rejection and the new grounds of rejection remain improper for at least this reason. Also, as discussed below, *Dart* fails to teach or suggest the elements for which it is cited.

III. Rejections under 35 U.S.C. § 103

Without conceding any other criteria for establishing a rejection under 35 U.S.C. §103, the rejection is improper at least because the applied combination of references does not teach or suggest all the limitations of independent claims 1-11 and 24-86. For brevity, only independent claim 1 is discussed below.

As discussed hereafter, the applied combination of references fails to teach or suggest various elements of independent claim 1, including at least i) “providing programming code for converting each contract into a plurality of terms and a contract identifier code, each term, of the plurality of terms, containing qualification codes, calculation codes and at least two priority notes, and arranging the plurality of terms, of said contract, into a sequential series of terms”, ii) “providing programming code for sequentially comparing each claim code, of the series of claim lines, against each qualification code, of the plurality of terms and when a claim code, of a claim line, is substantially equal to a qualification code, of a term, identifying said term as a matching term associated to said claim line”, and iii) “providing programming code for determining any priority conditions associated to all of the matching terms, and eliminating any matching terms that are excluded by said priority conditions; and providing programming code for determining a reimbursement amount for the claim by processing the calculation codes of the non-eliminated matching terms.” Thus, the rejection of claim 1 should fall.

First, independent claim 1 recites, in part, “providing programming code for converting each contract into a plurality of terms and a contract identifier code, each term, of the plurality of terms, containing qualification codes, calculation codes and at least two priority notes, and arranging the plurality of terms, of said contract, into a sequential series of terms”. The Examiner continues to rely upon *Tarter* as teaching this element. Specifically, as with the August 3, 2005 Office Action, the current Office Action asserts that column 15, lines 7-65 of *Tarter* teaches this element, *see* item 4(A) on Page 3 of the January 24, 2007 Office Action. However, as addressed in the Appeal Brief of October 30, 2006, the relied upon portion of *Tarter* in no way teaches or suggests the above element of claim 1. For example, there is no mention of qualification codes, calculation codes, or priority notes in the relied upon portion of *Tarter*. Additionally, the relied upon portion of *Tarter* further fails to teach or suggest “arranging the

plurality of terms, of said contract, into a sequential series of terms”. Further, *Dart* is not relied upon as teaching or suggestion this element, nor does it appear to do so.

Additionally, claim 1 further recites “providing programming code for sequentially comparing each claim code, of the series of claim lines, against each qualification code, of the plurality of terms and when a claim code, of a claim line, is substantially equal to a qualification code, of a term, identifying said term as a matching term associated to said claim line”. As with the previous Office Action of August 3, 2005, the current Office Action continues to rely upon *Tarter* as teaching this element. Specifically, the current Office Action continues to maintain that Col. 13, line 44 to Col. 15, line 39 of *Tarter* teaches this element, *see* item 4(A) on Page 3 of the current Office Action. Applicant respectfully disagrees for the reasons discussed in the Appeal Brief.

For instance, *Tarter* does not teach or suggest comparing each claim code of a series of claim lines against a qualification code. Further, *Tarter* does not teach or suggest identifying a term as a matching term associated to the claim line when a claim code of the claim line is substantially equal to the qualification code. These actions are completely absent from the relied upon teaching of *Tarter*. Additionally, it appears that *Dart* is not relied upon as teaching or suggesting this further element of claim 1, nor does it appear to do so.

Further still, claim 1 also recites “providing programming code for determining any priority conditions associated to all of the matching terms, and eliminating any matching terms that are excluded by said priority conditions; and providing programming code for determining a reimbursement amount for the claim by processing the calculation codes of the non-eliminated matching terms.” The current Office Action concedes that *Tarter* fails to teach or suggest these elements of claim 1, but asserts that these elements are found in *Dart*. Particularly, the current Office Action relies upon Col. 3, line 13 – Col. 4, line 63 of *Dart* as teaching or suggesting the above elements of claim 1, *see* page 4 of the current Office Action. Applicant respectfully disagrees.

In general, *Dart* is directed to a software program that assists a physician in forming a proper claim that contains the proper codes for services rendered to a patient so that the resulting

claim that is submitted for reimbursement by an insurer (e.g., Medicare, etc.) is compliant with rules and regulations pertaining to such claims to prevent the physician from encountering penalties associated with submitting non-compliant claims. While *Dart* aids a physician in preparing a compliant claim for services rendered to a patient, *Dart* is not directed to repricing such a reimbursement claim under at least one contract. That is, *Dart* is not concerned with how the reimbursement claim is processed (e.g., against a contract) for payment to the physician. Instead, *Dart* is solely concerned with aiding a physician in forming a compliant claim in the first place. *Dart* in no way teaches or suggests comparing each claim code against each qualification code to identify matching terms, and determining any priority conditions associated to all of the matching terms and eliminating any matching terms that are excluded by the priority conditions. Again, *Dart* is simply not concerned with processing a claim code against a contract to identify matching terms, but is rather merely directed to forming a compliant claim in the first place.

In view of the above, Applicant respectfully requests that the review panel reverse the outstanding rejection of at least claim 1. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-3948, under Order No. 66729/P017US/10405597 from which the undersigned is authorized to draw.

Dated: April 24, 2007

Respectfully submitted,

By 

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08/30/2006	HGUTEMA1	70	SALE	1401	A	500.00	09577386	503948
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